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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,594	11/28/2000	Edward J. Dalgewicz III	04756.00005	5231

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EXAMINER

LEE, EDMUND H

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,594

Applicant(s)

DALGEWICZ, EDWARD J.

Examiner

EDMUND H. LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-73 is/are pending in the application.
- 4a) Of the above claim(s) 59-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 47-58 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,7,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 47-58, drawn to a thermoforming process, classified in class 264, subclass 522.
 - II. Claims 59-73, drawn to a food tray, classified in class 428, subclass 36.8.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as injection molding, transfer molding, compression molding, or cold forming.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with P. Rivard on 10/7/03 a provisional election was made without oral traverse to prosecute the invention of group I, claims 47-58. Affirmation of this election must be made by applicant in replying to this Office action. Claims 59-73 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Claims 47-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "4 to about 15 wt%" (cl 47, ln 4) is indefinite because it is unclear as to what is the basis. If it is based upon the total weight of the composition then it should be positively and clearly recited as such.

The phrase "0.1 to about 4 wt%" (cl 47, ln 6-7) is indefinite because it is unclear as to what is the basis. If it is based upon the total weight of the composition then it should be positively and clearly recited as such.

The phrase "following heat setting" (cl 54, ln 1) is indefinite because there is no previous step of heat setting.

Claim 54 is indefinite because the phrase "following heat setting" (cl 54, ln 1) conflicts with the remainder of the claim. If the polymer is heat set then the final intrinsic viscosity cannot be at least 70% of the initial intrinsic viscosity. A heat set article is an article that is cured.

Clarification and/or correction is required.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 47-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheung et al (USPN 4981631) in view of Nelsen et al (EP 0838501 A2). In regard to

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claim 47, Cheung et al teach the basic claimed process including preparing a polymeric composition comprising an alkylene terephthalate bulk polymer (col 3, lns 40-50; col 7, ln 22-col 12, ln 51); extruding the composition through an extrusion die to form a thermoformable extrudate in a substantially non-oriented state (col 3, lns 40-50; col 7, ln 22-col 12, ln 51); contacting the extrudate with a shaping surface to thermoform the extrudate into at least one food tray (col 3, lns 40-50; col 7, ln 22-col 12, ln 51); and separating and recovering the at least one food tray (col 3, lns 40-50; col 7, ln 22-col 12, ln 51). However, Cheung et al do not teach all of the claimed components of the composition. Nelsen et al teach compositions for toughening polyester resins (pg 3, ln 25-pg 5, ln 11); preparing a polymeric composition comprising an alkylene terephthalate or naphthalate bulk polymer; from about 4 to about 15 wt% of an additive comprising a substantially amorphous co-polymer of ethylene and an acrylate; and from about 0.1 to about 4 wt% of a compatibilizer/emulsifier/surfactant (CES) comprising a grafter or backboned co-polymer or ter-polymer of ethylene and glycidyl acrylate or maleic anhydride (pg 3, ln 25-pg 5, ln 11); compounding the components of the compositions in an extruder (pg 6, lns 6-48); and molding the composition into a number of industrially useful products (pg 6, lns 6-48). Cheung et al and Nelsen et al are combinable because they are analogous with respect to molding an article from a polymeric composition having an alkylene terephthalate bulk polymer. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the composition of Nelsen et al into the process of Cheung et al in order to form a food tray having high impact resistance. In regard to claim 48, Cheung et al teach using one of

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the claimed bulk polymers as recited in claim 48 (col 3, Ins 40-50; col 7, In 22-col 12, In 51). In regard to claims 49-50, such is taught by the above combination of Cheung et al and Nelsen et al. In regard to claims 51-53, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the claimed hardness is well-known in the food tray art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mold the tray of Cheung et al to have the claimed hardness in order to form a durable tray. In regard to claims 54-57, Cheung et al teach a bulk polymer that is heat seat (col 3, Ins 40-50; col 7, In 22-col 12, In 51)--as a note, the heat setting of the bulk polymer of Cheung et al meets the claimed intrinsic viscosity limitations. In regard to claim 58, it is well-known in the molding art in order to reduce costs. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the trimmed and removed portions of the extrudate of Cheung et al with virgin material in order to reduce material costs.


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dunning et al (USPN 6033748) teach molding a food tray from a polyester composition.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 703.305.4019. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 703.305.5493. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.


EDMUND H. LEE
Primary Examiner
Art Unit 1732
10/20/09

EHL